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Applicant : Florence P. Haseltine
Serial No. : 09/727,593
Filed : December 4, 2000
Title : PROVIDING ELECTRONIC ACCESS TO CONSUMER-CUSTOMIZED
NONVERBAL INFORMATION REGARDING PRODUCTS AND SERVICES

Art Unit : 3625
Examiner : Robert E. Rhode, Jr.

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REINSTATEMENT OF APPEAL

Applicant hereby requests that the appeal to the Board of Patent Appeals and Interferences noted on August 30, 2004 be reinstated. Attached is a supplemental appeal brief.

Please apply the appeal fee filed on August 30, 2004. Please apply any other charges or credits to Deposit Account No. 06-1050.

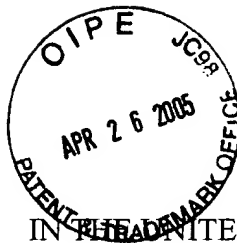
Respectfully submitted,

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4/26/05

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Mail Stop Appeal Brief - Patents

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SUPPLEMENTAL BRIEF ON APPEAL

(1) Real Party in Interest

The real party in interest is Florence Haseltine.

(2) Related Appeals and Interferences

There are no related appeals and interferences.

(3) Status of Claims

Applicant incorporates by reference the status of claims included in the appeal brief filed November 30, 2004, which indicates:

Rejected Claims

1, 3, 4, 6-18, 21, 23, 24, 26-38, 41, 43, 44, 46-58, and 61-96.

Cancelled Claims

2, 5, 19, 20, 22, 25, 39, 40, 42, 45, 59, and 60.

Claims Appealed

1, 3, 4, 6-18, 21, 23, 24, 26-38, 41, 43, 44, 46-58, and 61-96.

Applicant notes that the Office Action dated January 26, 2005 indicates that claim 22 is pending; however, claim 22 has been cancelled.

(4) Status of Amendments

Applicant incorporates by reference the status of amendments included in the appeal brief filed November 30, 2004, which indicates that the amendment filed August 30, 2004 was entered by the advisory action dated November 17, 2004. No amendments have been filed since then.

(5) Summary of Claimed Subject Matter

Applicant incorporates by reference the summary of claimed subject matter included in the appeal brief filed November 30, 2004, which states:

The subject matter of independent claims 1, 21, 41, 67, 77, and 87 may be employed to allow, for example, a third party to contribute to a consumer's shopping experience without being physically present at the merchant's physical premises. Application, page 2, lines 1-6. For example, a consumer may try on clothing at merchant's retail store. Application, page 7, lines 28-31. The merchant then may take a photograph of the consumer trying on the clothing and load the image onto a merchant system such as a website. Application, page 8, lines 19-25; page 6, lines 10-18. A device that is physically remote from the store, such as a computer executing web browsing software, may be used by a third party to access the merchant website and view the digital photograph so that the third party can see what the clothing looks like on the consumer. Application, page 4, lines 18-21; page 9, lines 1-6.

The third party can then contribute to the shopping experience, e.g., by providing authorization for the purchase of the product, selecting the product to be purchased, or giving the consumer feedback on the product. Application, page 8, lines 9-13. Thus, the consumer can be assisted by third parties during his or her shopping, without the necessity of the third parties being physically present.

More generally, independent claims 1, 21, and 41 are directed to a method, a computer medium or propagated signal, and an apparatus, respectively, for providing a party accessing a merchant system with electronic access to an image of merchandise physically arranged according to a consumer. A consumer is provided with access to physical merchandise at a merchant's physical premises. Application, page 7, lines 24-31. The consumer is allowed to direct the physical arrangement of the physical merchandise at the merchant's physical premises. Application, page 7, lines 24-31; Fig. 2, element 230. An image of the physical merchandise as physically arranged at the merchant's physical premises according to the consumer is captured

and loaded onto a merchant system. Application, page 7, lines 24-31; Fig. 2, element 240. A device, which is physically remote from the merchant's physical premises, is provided with access to the merchant system. Application, page 8, lines 1-13 page 9, lines 1-6; Fig. 2, element 240; Fig. 3, element 340. The party who is operating the device is enabled to access and view the captured image. Application, page 8, lines 1-13 page 9, lines 1-6; Fig. 2, element 250.

Independent claims 67, 77, and 87 are directed to a method, a computer medium or propagated signal, and an apparatus, respectively, for receiving feedback from a party regarding consumer-customized nonverbal information. An electronic version of consumer-customized nonverbal information is collected at a merchant's physical premises. Application, page 7, lines 24-31; Fig. 2, element 240. The electronic version of the consumer-customized nonverbal information is transmitted to a remote site for viewing by a party. Application, page 4, lines 18-23; page 8, lines 1-13; Fig. 2, element 250. Feedback is solicited and received from the party regarding the electronic version of the consumer-customized nonverbal information transmitted to the remote site for viewing by the party. Application, page 4, lines 18-23; page 8, lines 1-13; Fig. 2, element 260; Fig. 3, element 350.

(6) Grounds of Rejection

Claims 1, 3, 4, 6-18, 21, 23, 24, 26-38, 41, 43, 44, 46-58, and 61-96 are rejected as obvious over U.S. Patent No. 5,551,021 (Harada) in view of U.S. Patent No. 6,578,072 (Watanabe)

(7) Argument

The January 26th Office Action removes the rejection of claims 67, 77, and 87 as anticipated by Harada and, instead, rejects those claims as obvious over Harada in view of Watanabe. The rejections of all other pending claims, and rationale provided in support of those rejections remain the same as in the April 29th Office Action.

Even though the January 26th Office Action changes the rejection of claims 67, 77, and 87 to an obviousness rejection, the rejection of these claims as obvious was addressed in the November 30th appeal brief. While the April 29th Office Action had not rejected claims 67, 77, and 87 as obvious over Harada in view of Watanabe, Applicant addressed the obviousness of

these claims in the November 30th appeal brief in an attempt to expedite prosecution of this case, particularly because the Examiner had used the combination of Harada and Watanabe to reject claims 14, 34 and 54, which are dependent claims reciting features similar to those recited by claims 67, 77 and 87.

The January 26th Office Action now uses Harada and Watanabe to reject claims 67, 77, and 87 as obvious based on similar rationale as used in the April 29th Office Action to reject dependent claims 14, 34, and 54. Accordingly, all issues raised in the November 30th appeal brief with respect to the obviousness of claims 67, 77, and 87, in addition to the obviousness of the other pending claims, is still considered to be relevant. As such, Applicant incorporates by reference the arguments with respect to the rejections under 35 USC 103 presented in the November 30th appeal brief, namely, that (1) none of the claims are rendered obvious by Harada and Watanabe because the combination of the two would be contrary to the teachings of Harada and, therefore, there is no motivation to combine the two; and (2) Harada and Watanabe fail to disclose all of the claim limitations of claims 15, 16, 35, 36, 55, 56, 68, 69, 78, 79, 88, and 89 and, therefore, even if combination of the two is proper, such a combination does not render those claims obvious.

This brief supplements the November 30th appeal brief by addressing two items from the January 26th Office Action. First, this brief addresses the specific motivation to combine Harada and Watanabe described by the January 26th Office Action. Second, this brief addresses the points raised in the Response to Arguments included in the January 26th Office Action.

1. The Obviousness Rejections Impermissibly Use Applicant's Disclosure To Provide the Motivation to Combine Harada and Watanabe

The motivation to combine described in the January 26th Office Action is not present in the prior art and, therefore, the Office Action is impermissibly using Applicant's disclosure to provide the motivation to combine. To establish a *prima facie* case of obviousness, there must be a motivation or suggestion to combine or modify the references to obtain the claimed subject matter. See MPEP 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). This motivation must be in the prior art, and not taken from the Applicant's disclosure. *Id.* In

the present case, neither Harada or Watanabe provide the motivation relied on in the Office Action. Rather, the motivation relied upon is that given by Applicant's disclosure.

The January 26th Office Action provides the following as the motivation to combine Harada and Watanabe:

Harada discloses method, medium and apparatus a merchant method and system, which discloses capturing of an image, loading a captured image and allowing a device access and viewing of captured images (Abstract). Watanabe in turn discloses a method, medium and apparatus to remotely access and to view captured images (Figures 1-6). Therefore, one of ordinary skill in the art would have been motivated to combine Harada with Watanabe in order to have a method, medium and apparatus disclosing the capturing of an image of a consumer with tried on merchandise, loading the captured image and allowing device both local and remote access an viewing of captured images. In this manner, the consumer as well as others can view the captured image of the consumer. Thereby, the method and system will allow feedback from other parties that the consumer values and thereby ensure that the nonverbal information is the best suited for them as well as storing for future reference and approval if required. Moreover, this online collaboration will ensure that the purchase is most appropriate and thereby increase the consumer's satisfaction with the purchase. In turn, the increased satisfaction of the consumer will increase the probability that they will return for additional purchases as well as recommend the site/store to others.

January 26th Office Action, Page 5, Line 15 to Page 6, Line 10 (emphasis added). The underlined portion appears to indicate that one of skill in the art would be motivated to combine Harada and Watanabe to allow others to remotely view the captured image stored in the customer management system because such a combination would allow the consumer to obtain feedback about whether the merchandise is best suited for them.

However, Harada does not describe or suggest that consumers as well as others should be able to view the stored image of arranged physical merchandise or other consumer customized non-verbal information, nor does Harada describe or suggest that a party remote from the merchant site should be able to provide feedback so that a customer can insure the physical merchandise or other consumer customized non-verbal information is appropriate for the customer. In fact, as discussed in the arguments presented in the November 30th appeal brief and discussed below, Harada seeks to keep the stored digital image a secret from the consumer. Only retail store employees, located in the store, have access to the digital photographs stored in the

Harada customer management system. Therefore, Harada does not describe or suggest that parties remote from the merchant site should be able to view the stored images or provide feedback.

Watanabe does not even describe or suggest pictures of consumer customized non-verbal information or pictures of physical merchandise as physically arranged by a consumer. Nor does Watanabe describe or suggest that a party remote from a merchant site should be able to view pictures of physical merchandise as arranged by a consumer or be able to provide feedback on such merchandise.

Accordingly, the desirability of allowing others remote from the merchant site to view captured images of physical merchandise as arranged by the customer or to give feedback is only provided in Applicant's specification (see, e.g., Summary), and is not present in Harada or Watanabe. As such, the January 26th Office Action fails to establish a *prima facie* case of obviousness.

2. Response to Arguments in January 26th Office Action

The Response to Arguments in the January 26th Office Action attempts to make three points: (A) that Harada does not teach away from the combination of Harada and Watanabe because Harada does not teach keeping photographs a secret from the consumer; (B) that Harada teaches transmitting the digital photographs by CD-ROM, and, therefore, suggests transmitting the digital photographs over a network for viewing by a party remote from the merchant site; and (C) that Watanabe teaches receiving and soliciting feedback that includes an authorization for purchase. Each of these items are addressed in turn below.

A. Harada seeks to keep the stored photograph a secret from the consumer and, therefore, Harada teaches away from a combination of Harada and Watanabe

In the November 30th appeal brief, Applicant demonstrated that the combination of Harada and Watanabe goes against the teachings of Harada because Harada seeks to keep the digital photograph stored in the customer management system a secret from the consumer. November 30th Appeal Brief, Pages 4-7. The January 26th Office Action attempts to respond by asserting that Harada fairly suggests the customer awareness of the digital photographs being

stored in a customer management system. The January 26th Office Action attempts to support this contention of customer awareness of the digital photographs being stored in the customer management system based on two points: (1) a copy of the photograph is given to the customer, and (2) Harada discloses displaying photographs of the customer during house calls (referring to Col. 6, lines 3-17 and Figure 1). January 26th Office Action, page 13, lines 10-13. Applicant disagrees with this assertion because (1) Harada provides a copy of the photograph to the consumer but prevents the consumer from knowing the photograph is downloaded and stored in the customer management system; and (2) Harada does not disclose that photographs of customers are shown during house calls.

More particularly, with regard to (1), Harada discloses printing a copy of the photograph showing the customer trying on clothing and providing a print of the photograph to the customer. To do so, the camera is connected to a video printer (not the customer management system). Harada, Col. 4, Lines 5-9; Col. 8, Lines 55-58; Col. 9, Lines 44-47; Col. 10, Lines 21-24. However, just because a customer is provided with a print of a picture does not mean that the customer is aware that the digital photograph will then be downloaded from the camera to the customer management system. In fact, Harada systematically prints out the photograph before downloading the photograph to the customer management system and then waits until the customer leaves before downloading the photograph to the customer management system. More specifically, as described in the November 30th appeal brief, in all of the usage scenarios described by Harada, except one, the electronic image in the digital camera is not downloaded to the customer management system until “after the customer leaves the shop.” Harada, Col. 9, Line 11-12; Col. 9, Line 55-56; Col. 10, Line 28-29 (emphasis added). Thus, even though Harada makes the customer aware that a photograph has been taken, Harada explicitly prevents the customer from knowing the photograph is downloaded and stored in the customer management system.

The one exception to this is when the customer is coming to the store to decide on some custom made clothing. The employee photographs the customer, but not any merchandise. That is, the picture is simply of the customer, not the customer trying on clothing. Harada, Col. 10, Line 53-62. In this case, Harada teaches techniques to be sure “the customer cannot know that the images photographed at other timings are utilized in customer management.” Harada, Col.

10, Lines 62-65 (emphasis added). Specifically, to prevent the customer of knowing about the images from other timings, Harada teaches that the customer should only be shown the picture customer without merchandise. *Id.*

Accordingly, while Harada may not keep the taking of the photographs a secret, Harada does indeed keep the digital photograph loaded into the customer management system a secret from the customer. Because Harada seeks to keep the stored digital photographs a secret from the consumer, Harada can not suggest incorporating features that allow the customer, as well as others, to view the digital photographs of the customer trying on clothes that are loaded into the customer management system. Doing so would destroy the secrecy of such digital photographs and, therefore, would be directly contrary to the teachings of Harada.

With respect to (2), the assertion in the January 26th Office Action is simply incorrect. When a store employee makes a house call, the employee does not bring photographs of a customer wearing clothing. Rather, as is made clear from the sentences preceding the section cited in the January 26th Office Action, all that Harada discloses in such situations is that the store employee brings photographs of clothing available for sale. Specifically, col. 5, line 55 to col. 6, line 6 (emphasis added) reads as follows:

The recording medium, such as the memory card 12 or compact HD 16, is installed in a house-to-house sales tool 48. The card camera in the image generator 10 may be used directly as this tool 48. That is, image data electronically stored in the installed recording medium may be displayed on a small color display like a color liquid crystal display or the card camera may be connected to a color video printer or the like as needed to print out the image data to help explain popular merchandise in a customer's house, another sales company, a retail shop or the like. Assuming that there are top ten well-selling clothes and information thereon are stored and organized in the data storage section 22, then the mobility is apparently improved significantly if the images of those clothes are saved on a recording medium, such as the memory card 12, and the salesman or saleswoman brings the recording medium and the card camera along than if the salesperson actually brings the clothes along. The house-to-house sales tool 48 may be a compact and light computer or a so-called notebook computer, as well as the card camera.

As can be seen, this section simply describes storing images of clothing to be shown to a customer, not images of the customer trying on clothes. Accordingly, this section can not

suggest that the customer is made aware of digital photographs of the customer trying on clothing stored in the customer management system.

Therefore, contrary to the assertions in the January 26th Office Action, Harada specifically teaches that the digital photographs stored in the customer management system are kept a secret from the customer. Accordingly, as described in the November 30th appeal brief, incorporating features from Watanabe in the manner suggested by the Office Action would be directly contrary to these teachings of Harada.

B. Harada teaches backing up the photographs on CD-ROM, not using a CD-ROM to transfer the photographs to a remote location for viewing by a party at the remote location

The January 26th Office Action asserts that Harada discloses transferring the digital photographs using CD-ROMs and, therefore, suggests transferring the photographs over a network to a remote site for viewing by a remote party. January 26th Office Action, Page 13, Line 17 to Page 14, Line 8 (citing Col. 6, Lines 3-17, Figure 1, and Figure 22A). Simply, the sections referred to by the January 26th Office Action describe *backing up* the digital photographs on a CD-ROM. Specifically, the introduction to the section cited by the Office Action states: "Alternatively, this method [for selecting an image] can be adapted for an operation to transfer an image file that is used for backup purposes." See, Harada, Col. 13, Lines 62-63. Transferring a digital photograph to a CD-ROM for a backup does not suggest using a network to transfer the digital photograph to a remote location for viewing by a party at the remote location.

C. Watanabe teaches purchase of a photograph, not physical merchandise shown in a digital photograph

The November 30th appeal brief demonstrated how neither Harada or Watanabe disclose or suggest the subject matter of dependent claims 15, 16, 35, 36, 55, 56, 68, 69, 78, 79, 88, and 89 and that a combination of Harada and Watanabe would therefore not provide for the subject matter recited in these claims, even if a combination of the two references was proper. In response, the January 26th Office Action first asserts that (1) Harada describes and suggests the

purchase of physical merchandise and that Watanabe discloses the capability for soliciting feedback and well as receiving feedback, which includes a purchase. January 26th Office Action, Page 16, Lines 8-11. The Office Action additionally asserts that (2) online collaboration between a sales agent and a third party is old and well known and is often used to obtain authorization to purchase. January 26th Office Action, Page 16, Lines 11-16.

With regard to the first assertion, claims 15, 16, 35, 36, 55, 56, 68, 69, 78, 79, 88, and 89 recite that the feedback includes an authorization for a purchase of the physical merchandise or a recommendation for purchase. While Harada discloses purchasing merchandise, Harada does not disclose feedback that includes an authorization for purchase or a recommendation for purchase, and therefore fails to meet the claims.

The January 26th Office Action continues to, at least implicitly, concede this point,¹ by asserting that Watanabe has these features, without reference to Harada. Applicant disagrees, however, with the assertion that Watanabe describes or suggests these features.

Watanabe discloses that a user can purchase photographs, not merchandise pictured in the photographs. Watanabe, Col. 4, Lines 10-12 (“[T]he system may comprise print ordering means for ordering prints of the images disclosed on the network by the group image disclosing means.”). Therefore, Watanabe does not disclose feedback that includes an authorization for purchase of the physical merchandise, as claimed. Further, Watanabe simply does not disclose feedback that includes recommendation for a purchase, as claimed.

Accordingly, neither of these references disclose or suggest the subject matter of dependent claims 15, 16, 35, 36, 55, 56, 68, 69, 78, 79, 88, and 89. As such, even if the combination of Watanabe and Harada was proper, the combination of these references does not provide for the subject matter of claims 15, 16, 35, 36, 55, 56, 68, 69, 78, 79, 88, and 89.

With regard to the second assertion, the January 26th Office Action provides no evidence to support the assertion that online collaboration between a sales agent and a third party is well known and often used to obtain an authorization to purchase. The simple assertion that this is old and well known is not sufficient to make out a *prima facie* case of obviousness. See, e.g.,

¹ The portion of the Office Action rejecting these claims only refers to Watanabe having these features. January 26th Office Action, page 9, lines 5-15. As these claims are rejected under 35 USC 103, it is assumed that this rejection is based on the combination of Harada and Watanabe, and that Watanabe is described because Harada does not disclose these features.

MPEP 2142 (describing the necessity of the Examiner to come forward with evidence to make out a *prima facie* case of obviousness). To the extent that the Examiner is taking Official Notice that such online collaboration was well known as of the filing date of the present application, Applicant requests that the Examiner produce documentary evidence supporting this assertion.


3. Conclusion

For the reasons describe above, and for the reasons described in the November 30th appeal brief, the rejections of claims 1, 3, 4, 6-18, 21, 23, 24, 26-38, 41, 43, 44, 46-58, and 61-96 should be reversed.

Please apply the brief fee previously paid with the submission of the appeal brief filed on November 30th 2004 to the reinstatement of this appeal. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Appendix of Claims

Applicant incorporates by reference the appendix of claims provided in the appeal brief filed November 30, 2004.